

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

APR 26 1999

In re)	
Petitioner)	Decision on Petition
_____)	under 37 C.F.R. § 10.2(c)

MEMORANDUM AND ORDER

("Petitioner") requests review under 37 C.F.R. § 10.2(c) of a decision of the Director of the Office of Enrollment and Discipline ("Director"), entered August 7, 1998, denying his request, filed March 23, 1998, for a higher score on the morning section of the Registration Examination to Practice in Patent Cases before the U.S. Patent and Trademark Office ("examination"), held on August 27, 1997. The petition is hereby denied.

SUMMARY

The Director's decision was on a request, under 37 C.F.R. § 10.7(c), for regrade of the morning section of the examination. Petitioner scored 66 points on this portion of the examination. Since 70 points are required to attain a passing score, Petitioner was short 4 points. The Director, in her August 8, 1998 decision, added no points to Petitioner's score. This review of the Director's decision has resulted in no additional points being awarded. Petitioner's score remains at 66, four points short of the passing score of 70.

FACTS AND LEGAL DISCUSSION

The examination tests an applicant's knowledge of the relevant statutes, regulations, and policies that apply to patent examination and prosecution. The examination consists of hypothetical fact patterns followed by "multiple choice" questions, and the examinee must select

the answer to these questions which is “most correct” given the context of the hypothetical. In assessing each hypothetical fact pattern, the examinee must exercise independent professional judgment as would be expected of a patent practitioner who is providing advice to a client and making representations to the PTO. The “Directions” printed on the first page of the examination include the following statements:

Do not assume any additional facts not presented in the questions.

When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. . . The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question.

At issue are three examination questions: 21, 26, and 29.

I. Question 21

This question is set forth in its entirety below:

21. Which of the following is a printed publication under 35 U.S.C. § 102(a) which may be used to defeat the patentability of an invention conceived and reduced to practice in Des Moines, Iowa, on December 14, 1996?
- (A) A doctoral thesis shelved at a California university library, indexed only by subject, and cataloged in the library card catalog on June 15, 1996.
 - (B) A doctoral thesis shelved at a California university library and indexed only by graduating class prior to December 13, 1995.
 - (C) A doctoral thesis orally presented to members of a California university graduate committee prior to December 13, 1995.
 - (D) An oral presentation of research to members of the public in England on December 13, 1995.
 - (E) None of the above.

The correct answer is “A.” Petitioner argues that the correct answer should be “E.”

This question tests the examinee’s knowledge of potential sources of prior art, namely, what qualifies as a “printed publication” under 35 U.S.C. § 102. The Federal Circuit has held that a doctoral thesis, cataloged by subject and accessible on the shelves of a university library, is a printed publication within the meaning of 35 U.S.C. § 102. In re Hall, 228 USPQ 453, 456, 781 F.2d 897, 899 (Fed. Cir. 1986). Thus, choice “A” is correct.

Petitioner argues that choice “A” cannot be correct for two independent reasons: (1) that there is no indication that the thesis in choice “A” discloses the claimed invention, and (2) that the author of the thesis may in fact be the inventor in the hypothetical and therefore would not have his own publication cited as prior art under 35 U.S.C. § 102. These arguments are unpersuasive. In order for Petitioner’s arguments to have merit, it would be necessary to assume certain facts that are beyond those disclosed in the hypothetical. Given the admonishment for the examinee not to assume additional facts beyond those in the hypothetical as well as the requirement to choose the “most correct answer,” choice “A” is correct. Petitioner has not demonstrated an error in grading. Therefore, no additional points are warranted for question 21.

II. Question 26

The question is set forth in its entirety below.

26. V has invented a new composition for stabilizing and preserving blood products. On October 30, 1992, V filed a patent application in the PTO for his composition. The specification discloses that the composition includes: 10 to 40 percent active component, preferably 20 to 35 percent active component; 5 to 20 percent preservative, preferably 10 to 15 percent preservative; and 40 to 85 percent water, preferably 50 to 70 percent water. The patent issued on April 5, 1994, with the following single claim:

- I. 1. A blood preservative composition comprising 20 to 30 percent active component; 5 to 20 percent preservative; and 40 to 85 percent water.

On the evening of March 31, 1996, you receive a telephone call from V. In reviewing his patent, he has discovered an error in the patent that occurred without deceptive intent. He wants you to prepare a reissue application and make the following amendment to Claim 1 and add two claims:

- I. 1. A blood preservative composition comprising [20] 10 to [30] 40 percent active component; 5 to 20 percent preservative; and 40 to 85 percent water.
- II. 2. The blood preservative composition of claim 1, wherein the composition comprises 10 to 15 percent preservative.
- III. 3. A blood preservative composition comprising 20 to 35 percent active component; 10 to 15 percent preservative; and 50 to 70 percent water

You prepare and file the reissue application on April 1, 1996. Which of the above claims is/are proper in the reissue application?

- (A) I.
- (B) II.
- (C) I and II.
- (D) II and III.
- (E) I, II, and III.

The Director indicates choice (E) is the most correct answer, that is, all three claims are proper.

Petitioner argues that choice (A) is correct, meaning that he believes only claim 1 is proper.

This question tests the examinee's knowledge of reissue practice. The reissue statute,

35 U.S.C. § 251, provides in pertinent part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of . . . the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall . . . reissue the patent for the invention disclosed

The provisions of this title relating to applications for patent shall be applicable to applications for reissue

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

With these statutory requirements in mind, the following analysis is provided.

Claim 1, which broadens the scope of the original claim, is proper because it conforms to the requirements of 35 U.S.C. § 251. The Petitioner agrees that Claim 1 is proper.¹

Claim 2 is a dependent claim, and is in proper form. It complies with 35 U.S.C. § 112, the pertinent parts of which are set forth below:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention

. . . a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Moreover, 37 C.F.R. § 1.75(c) provides in pertinent part

One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.

Claim 2 complies with the statutory and regulatory requirements. The Petitioner, however, argues that claim 2 is improper because

the proper transitional phrase for a dependent claim is “further comprises” where the dependent claim is intended to be closed-ended (clearly the intent here), or “further comprising” in the case where the dependent claim is designed to be open-

¹ 37 C.F.R. § 1.75(i) states that “[w]here a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.” Claim 1 arguably does not conform to this regulation, but Petitioner has not raised the issue.

ended. (Emphasis in original.)

Petitioner cites no authority for this proposition. Neither the controlling statute nor the regulation require the “further comprising” language as argued by Petitioner. Therefore, Petitioner’s argument is without merit. Claim 2 is a proper claim.

Claim 3 would be a proper claim but for a typographical error--it lacks a terminal period. The Petitioner asserts that a claim without a period is per se improper. The Director indicates that the typographical error did not make the claim improper given the circumstances, namely, that the question was intended to test the examinee’s knowledge of reissue practice particularly as it relates to the scope of the claims, and that a typographical error can be properly corrected by later amendment. Nonetheless, the “one sentence rule,” which is set forth in MPEP § 608.01(m), provides that “each claim begins with a capital letter and ends with a period.” The rule has been upheld by a D.C. District Court. Fessola v. Manbeck, 36 USPQ2d 1211, 1214-15 (D.D.C. 1995). Therefore, Claim 3 as written is in improper form.

To summarize, Petitioner argues that choice (A) is correct, meaning that he believes only claim 1 is proper. The Commissioner agrees that claim 1 is proper, but for not indenting the plurality of elements. Petitioner further contends that Claim 2 is improper. However, Claim 2 is in fact proper. Since Petitioner’s argument depends on claim 2 being improper, and since claim 2 is in fact acceptable, Petitioner’s reasoning therefore fails. He is not entitled to any additional points for question 26.

III. Question 29

This question is set forth in its entirety below:

29. You have filed a complete plant patent application claiming 1) a

distinct and new plant variety and 2) a method for obtaining the plant variety. Which of the following statements is/are false?

- I. You may not amend the application to add additional description of the plant variety inadvertently omitted from the original application.
 - II. You may be required to deposit an adequate sample of the plant variety with an acceptable depository and the claims may be rejected under 35 U.S.C. § 112 without the deposit.
 - III. You may be required to restrict the claims between plant variety and plant method inventions you want examined for ultimate issuance as the single claim in the plant patent application to which you are entitled.
- (A) III.
 - (B) II and III.
 - (C) I and II.
 - (D) I and III.
 - (E) I, II, and III.

The correct answer is (C). Petitioner argues that the correct answer should be (E). The Director and Petitioner both agree that statements I and II are false. There is disagreement, however, regarding statement III. The Director takes the position that statement III is true, while Petitioner argues that it is false.

Petitioner argues that statement III is false because the term “may be required” implies that it might be possible for a method claim to subsist in a plant patent. To be precise, the Petitioner asserts that

Statement III is false because . . . as you are well aware, a plant patent can **never** include a method claim and it **must** be canceled. An Examiner would unconditionally require the applicant to cancel the claim to a method for a plant patent prior to issuance. The word “may” in Statement III allows for the possibility that an Examiner might not require cancellation. This possibility is clearly **false**. The applicant absolutely **must** cancel the method claim. (Emphasis in original.)

This argument is without merit. Statement III merely raises the issue that when more than one

invention is claimed in an application, the applicant “may be required to restrict” the claims.

35 U.S.C. § 121. Since statement III indicates that more than one invention is being disclosed in the application, restriction therefore may be appropriate. Furthermore, the “may be required” language is found in the statute and signals that the Commissioner (acting through the examiners) has the discretion to divide or restrict applications in order to facilitate examination. Petitioner’s argument that restriction is inappropriate therefore is without merit.

Petitioner argues that issuing a restriction requirement in the given fact pattern implies that a method claim in a plant patent application would be proper. The restriction statute, however, is silent as to the merits of the claims presented. Moreover, the ultimate patentability of any individual claim simply is independent of whether an examiner has required restriction in order to facilitate examination. Petitioner has offered no authority to the contrary. His argument therefore is without merit.

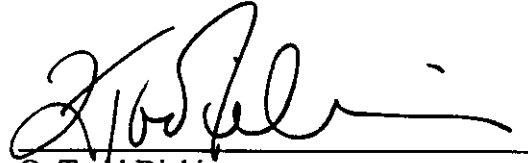
Petitioner also argues that statement III is false because the examiner would unconditionally require cancellation of the improper method claim in the plant patent application. This is also without merit. An examiner may simply choose to reject a method claim in a plant patent application as being non-statutory subject matter as defined by 35 U.S.C. § 161. The notion that an examiner would “unconditionally require” cancellation of a method claim in a plant patent application is not supported by the law.

Petitioner is not entitled to any additional points for question 29.

DECISION

Petitioner has not shown that the Director is in error or that he is otherwise entitled to additional points for questions 21, 26, or 29. Hence, no additional points are awarded.

Petitioner's score remains 66, which is four points below the passing score of 70. Petitioner has not attained a passing score on the registration examination. Petitioner's request for additional points is denied.

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks